



IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Ford

Confirmation No.: 5498

Application No.: 09/778,390

Examiner: Wang, Liang Che A

Filing Date: 2/7/01

Group Art Unit: 2155

Title: System and Method for Accessing Software Components on a Distributed Network Environment

Mail Stop Appeal Brief-Patents
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF APPEAL BRIEF

Sir:

Transmitted herewith is the Appeal Brief in this application with respect to the Notice of Appeal filed on May 16, 2005.

The fee for filing this Appeal Brief is (37 CFR 1.17(c)) \$500.00.

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

() (a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d) for the total number of months checked below:

() one month	\$120.00
() two months	\$450.00
() three months	\$1020.00
() four months	\$1590.00

() The extension fee has already been filled in this application.

(X) (b) Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

Please charge to Deposit Account **08-2025** the sum of \$500.00. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees. A duplicate copy of this sheet is enclosed.

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Respectfully submitted,

Ford

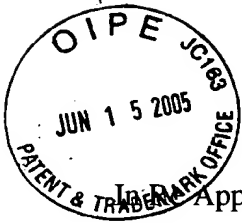
By Daniel R. McClure

Daniel R. McClure

Attorney/Agent for Applicant(s)
Reg. No. **38,962**

Date: **6/10/05**

Telephone No.: **(770) 933-9500**



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

AF
ZWH

Application of:

Ford

Serial No.: 09/779,390

Filed: February 7, 2001

For: System and Method for Accessing Software
Components on a Distributed Network
Environment

Group Art Unit: 2155

Examiner: Wang, Liang Che A.

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HP Docket No.: 10007261-1
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APPEAL BRIEF UNDER 37 C.F.R. §1.192

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P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

This is an appeal from the decision of Examiner Wang, Liang Che A., Group Art Unit 2155, mailed December 21, 2004, rejecting all claims 1-21 in the present application and making the rejection FINAL.

I. REAL PARTY IN INTEREST

The real party in interest of the instant application is Hewlett-Packard Development Company, a Texas Limited Liability Partnership having its principal place of business in Houston, Texas.

II. RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

III. STATUS OF THE CLAIMS

Claim 1-21 are pending in this application. As all claims 1-21 were rejected by the FINAL Office Action, all pending claims are the subject of this appeal. The Office Action rejected all claims 1-21 under 35 U.S.C. § 103(a) as allegedly obvious over the combination of U.S. Patent 6,693,896 to Utsumi et al (hereafter '896 patent or Utsumi) and U.S. Patent 6,542,942 to Gulati (hereafter '942 patent or Gulati).

IV. STATUS OF AMENDMENTS

No amendments have been made or requested since the mailing of the FINAL Office Action and all amendments submitted prior to the FINAL action have been entered. A copy of the current claims is attached hereto as Exhibit A.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Embodiments of the claimed subject matter are illustrated in FIGs. 2, 3A and 3B. The embodiments illustrated in FIGs. 3A and 3B are discussed in the specification at least at page 11, line 19 through page 19, line 16.

As embodied in claim 1, in a distributed computer networked system having at least one service consumer (*see e.g.*, ref. num. 214 and related description) and at least one service provider (*see e.g.*, ref. num. 212 and related description), a method accesses a remote software component by a service consumer (*see e.g.*, ref. num. 214 and related description) comprising: generating (*see e.g.*, ref. num. 252 and related description) a request for a component (*see e.g.*, p. 1, lines 19-21) having at least one specified attribute (*see e.g.*, ref. num. 230 and related description), broadcasting the request (*see e.g.*, ref. num. 220 and related description) across the network (*see e.g.*, ref. num. 216 and related description), receiving (*see e.g.*, ref. num. 262 and related description) the request (*see e.g.*, ref. num. 220 and related description) at a service provider (*see e.g.*, ref. num. 212 and related description), comparing (*see e.g.*, ref. num. 264 and related description) at least one specified attribute (*see e.g.*, ref. num. 230 and related description) of the received request with component attributes (*see e.g.*, specification p. 1, lines 19-21 and ref. num. 230 and related description) of the service provider (*see e.g.*, ref. num. 212 and related description), and communicating a

response (*see e.g.*, ref. num. 240 and related description) to the requesting service consumer (*see e.g.*, ref. num. 214 and related description).

As embodied in claim 12, a distributed computer networked system accesses a remote software component (*see e.g.*, specification p. 1, lines 19-21) comprising: at least one service consumer (*see e.g.*, ref. num. 214 and related description), at least one service provider (*see e.g.*, ref. num. 212 and related description), means (*see e.g.*, ref. num. 250 and 252 and related description) for generating a request (*see e.g.*, ref. num. 220 and related description) at a service consumer (*see e.g.*, ref. num. 214 and related description) for a component having a least one specified attribute (*see e.g.*, ref. num. 230 and related description), means for broadcasting the request (*see e.g.*, ref. num. 220 and related description) across the network (*see e.g.*, ref. num. 216 and related description), means (*see e.g.*, ref. num. 260 and 262 and related description) for receiving the request (*see e.g.*, ref. num. 220 and related description) at a service provider (*see e.g.*, ref. num. 212 and related description), means (260 and 264) for comparing the at least one specified attribute (*see e.g.*, ref. num. 230 and related description) of the received request (*see e.g.*, ref. num. 220 and related description) with component attributes of the service provider (*see e.g.*, ref. num. 212 and related description), and means (*see e.g.*, ref. num. 260 and 266 and related description) for communicating a response (*see e.g.*, ref. num. 240 and related description) to the requesting service consumer (*see e.g.*, ref. num. 214 and related description).

As embodied in claim 21, in a distributed computer networked system having at least one service consumer (*see e.g.*, ref. num. 214 and related description) and at least one service provider (*see e.g.*, ref. num. 212 and related description), a method accesses remote software components by a service consumer comprising: generating (*see e.g.*, ref. num. 252 and related

description) a request (*see e.g.*, ref. num. 220 and related description) for a component (*see e.g.*, specification p. 1, lines 19-21) having at least one specified attribute (*see e.g.*, ref. num. 230 and related description), broadcasting the request (*see e.g.*, ref. num. 220 and related description) across the network (*see e.g.*, ref. num. 216 and related description); receiving (*see e.g.*, ref. num. 262 and related description) the request (*see e.g.*, ref. num. 220 and related description) at each of a plurality of service providers (*see e.g.*, ref. num. 114, 126, 136, 212 and related description) on the network (*see e.g.*, ref. num. 216 and related description), comparing (*see e.g.*, ref. num. 264 and related description), at each of the plurality of service providers (*see e.g.*, ref. num. 114, 126, 136, 212 and related description), the at least one specified attribute (*see e.g.*, ref. num. 230 and related description) of the received request (*see e.g.*, ref. num. 220 and related description) with component attributes of the service provider (*see e.g.*, ref. num. 212 and related description), and communicating, from each of the plurality of service providers (*see e.g.*, ref. num. 114, 126, 136, 212 and related description), a response (*see e.g.*, ref. num. 240 and related description) to the requesting service consumer (*see e.g.*, ref. num. 214 and related description).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Independent claim 1 stands rejected under 35 U.S.C. § 103(a) as allegedly obvious over the combination of U.S. Patent 6,693,896 to Utsumi et al (hereafter '896 patent or Utsumi) and U.S. Patent 6,542,942 to Gulati (hereafter '942 patent or Gulati).

Independent claim 12 stands rejected under 35 U.S.C. § 103(a) as allegedly obvious over the combination of U.S. Patent 6,693,896 to Utsumi et al (hereafter '896 patent or Utsumi) and U.S. Patent 6,542,942 to Gulati (hereafter '942 patent or Gulati).

Independent claim 21 stands rejected under 35 U.S.C. § 103(a) as allegedly obvious over the combination of U.S. Patent 6,693,896 to Utsumi et al (hereafter '896 patent or Utsumi) and U.S. Patent 6,542,942 to Gulati (hereafter '942 patent or Gulati).

VII. ARGUMENT

Fundamental Distinction of All Claims Over Cited References

On a substantive basis, there is at least one fundamental distinction between the claimed invention and the cited art, which is applicable to all claims. The FINAL Office Action rejected all claims as allegedly obvious over the combination of Utsumi and Gulati. Applicant respectfully disagrees. The summary of the present application states:

The present invention is broadly directed to a system and method for accessing software components, interfaces, or resources in a distributed network environment. A distinctive feature of the invention is its ability to locate such components, interfaces, or resources based upon certain specified attributes, and without having prior knowledge of the address or location of the component, interface, or resource.

(Emphasis added.) This stated essence of Applicant's invention cannot be achieved in the system of Utsumi (or the combination of Utsumi with Gulati). This broadly-stated objective

or feature is achieved, in certain embodiments, by the broadcast (over a computer network) of a request for a component that has at least one attribute specified in the request. In addition to other features, every independent claim of the present application embodies at least the three features/concepts, which are underlined above. The rejections applied by the Office Action, however, have either blurred or ignored these features. For at least this reason, the rejections are misplaced and should be overturned. Further, the system disclosed in *Utsumi* relates to the reservation of a resource at the request of a user. The system of *Utsumi*, as described, requires *a priori* knowledge by the user of the resources of the system. In contrast, and as noted above, the presently-pending claims define systems and methods which have the “ability to locate such components, interfaces, or resources based upon certain specified attributes, and without having prior knowledge of the address or location of the component, interface, or resource.” For this reason alone, the Board should overturn all claim rejections as misplaced.

Further still, the system of *Utsumi* relates to the reservation of a resource at the request of the user. In contrast, the claimed invention relates to the identification of available components and not necessarily the reservation of the components. As an example, the specification describes a scenario in which a user specifies the component of a network printer having the attribute of color printing capability. In response to such a broadcasted request, the relevant network printers would reply to the request. The service consumer (e.g., user’s system) would then have an identification of the network printers capable of printing in color. At this point, however, none of the printers have been allocated to process a print job (e.g., these resources have not been reserved, but merely identified).

For at least these fundamental reasons, the application of *Utsumi* to the pending claims is misplaced and should be overturned by the Board.

Notwithstanding the foregoing global distinction that is applicable to all claims, independent claims 1, 12, and 21 will be individually discussed below.

Combination of Utsumi and Gulati is Improper

As a separate and independent basis for the patentability of all claims, Applicant respectfully submits that the combination of *Utsumi* and *Gulati* is improper and should be withdrawn.

The Office Action rejected all claims 1-21 as allegedly obvious over the combination of *Utsumi* and *Gulati*. In forming this rejection, the Office Action merely concluded that the combination of these two references would have been obvious “because the broadcasting method would facilitate the exchange of information, and multiple devices operatively connected to the network as taught by *Gulati* (Col 2 lines 18-21).” (Office Action, page 3, third paragraph). Ironically, this is identical (word-for-word) to the rationale espoused in the previous Office Action for combining *Gulati* with *Malik* (a reference no longer being applied). Applicant respectfully disagrees. Among other reasons for traversing this rejection, Applicant respectfully submits that this rejection falls far short of the legal requirements for forming rejections under 35 U.S.C. § 103(a).

In this regard, it is well-settled law that in order to properly support an obviousness rejection under 35 U.S.C. § 103, there must have been some teaching in the prior art to suggest to one skilled in the art that the claimed invention would have been obvious. W. L. Gore & Associates, Inc. v. Garlock Thomas, Inc., 721 F.2d 1540, 1551 (Fed. Cir. 1983). More significantly,

"The consistent criteria for determination of obviousness is whether the prior art

would have suggested to one of ordinary skill in the art that this [invention] should be carried out and would have a reasonable likelihood of success, viewed in light of the prior art. ..." Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure... In determining whether such a suggestion can fairly be gleaned from the prior art, the full field of the invention must be considered; for the person of ordinary skill in the art is charged with knowledge of the entire body of technological literature, including that which might lead away from the claimed invention."

(Emphasis added) In re Dow Chemical Company, 837 F.2d 469, 473 (Fed. Cir. 1988).

In this regard, Applicant notes that there must not only be a suggestion to combine the functional or operational aspects of the combined references, but that the Federal Circuit also requires the prior art to suggest both the combination of elements and the structure resulting from the combination. Stiftung v. Renishaw PLC, 945 Fed.2d 1173 (Fed. Cir. 1991). Therefore, in order to sustain an obviousness rejection based upon a combination of any two or more prior art references, the prior art must properly suggest the desirability of combining the particular elements to create a system or method for accessing a remote software component by a service consumer over a distributed computer networked system, as defined by the pending claims.

When an obviousness determination is based on multiple prior art references, there must be a showing of some "teaching, suggestion, or reason" to combine the references. Gambro Lundia AB v. Baxter Healthcare Corp., 110 F.3d 1573, 1579, 42 USPQ2d 1378, 1383 (Fed. Cir. 1997) (also noting that the "absence of such a suggestion to combine is dispositive in an obviousness determination").

Evidence of a suggestion, teaching, or motivation to combine prior art references may flow, inter alia, from the references themselves, the knowledge of one of ordinary skill in the art, or from the nature of the problem to be solved. See In re Dembiczak, 175 F.3d 994,

1000, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Although a reference need not expressly teach that the disclosure contained therein should be combined with another, the showing of combinability, in whatever form, must nevertheless be “clear and particular.” Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617.

If there was no motivation or suggestion to combine selective teachings from multiple prior art references, one of ordinary skill in the art would not have viewed the present invention as obvious. See In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); Gambro Lundia AB, 110 F.3d at 1579, 42 USPQ2d at 1383 (“The absence of such a suggestion to combine is dispositive in an obviousness determination.”).

Significantly, where there is no apparent disadvantage present in a particular prior art reference, then generally there can be no motivation to combine the teaching of another reference with the particular prior art reference. Winner Int'l Royalty Corp. v. Wang, No 98-1553 (Fed. Cir. January 27, 2000). The Office Action has failed to cite any apparent disadvantage of *Utsumi*, which would prompt the combination of select teachings of *Gulati* therewith.

For at least this separate and independent basis, the rejections of claims 1-21 should be withdrawn.

Claims 1-11 and claim 20

Turning now to the specific claims, the Office Action rejected independent claim 1 as allegedly obvious over the combination of *Utsumi* in view of *Gulati*. For at least the reasons set forth below, Applicant respectfully disagrees.

Independent claim 1 recites:

1. In a ***distributed computer networked system*** having at least one service consumer and at least one service provider, a method for accessing a remote software component by a service consumer comprising:
 - generating a request for a ***component having at least one specified attribute***;
 - broadcasting*** the request across the network;
 - receiving the request at a service provider;
 - comparing at least one specified attribute of the received request with component attributes of the service provider***; and
 - communicating a response to the requesting service consumer.

(*Emphasis added.*) Claim 1 patently defines over the cited art for at least the reason that the cited art fails to disclose the features emphasized above.

As an initial matter, Applicant notes that, with regard to the claimed element of “broadcasting the request across the network,” that the Office Action misinterpreted this element as “transmitting.” In this regard, the Office Action alleged (paragraph 4(b)) that “*Utsumi* has taught ... b. transmitting the request across the network (Col. 1 line 67-Col 2 line 4).” (*Emphasis added.*) “Transmitting” is a broader term than “broadcasting” (as the term is used in the context of the pending claims), and as such, the two cannot properly be treated as the same. Pages 13-15 of the present application describe the term “broadcast” in pages 13-15 to mean the communication, in a distributed network, of a message to a large number devices on the network. The specification describes that, although a number of broadcasting

methodologies could be utilized (p. 15, lines 5-6), UDP multicast messaging is preferred, as confirming reliable delivery to every device is not essential (p. 13, lines 20-24 and p. 15, lines 6-19). This alone reflects an error on the part of the Office Action that warrants reversal of the rejection.

In addition to the foregoing, col. 1 line 67 through col. 2 line 4 of *Utsumi* (the teaching of *Utsumi* relied upon for teaching the claimed “broadcasting ...” feature) actually states:

An information receiving apparatus according to the present invention, which is connected to an information providing apparatus by forming a connection in a communication network and which receives content information from the information providing apparatus through the connection...

As is clear from even a cursory reading, this portion of *Utsumi* does not teach, disclose, or suggest the claimed feature of “broadcasting the request across the network.” For at least this reason, the rejection of claim 1 is deficient and misplaced and should be overturned.

Further still, the Office Action characterized Figure 1 of *Utsumi* as disclosing the claimed “distributed computer networked system” (Office action, paragraph 4). However, the network disclosed in Figure 1 of *Utsumi* is an ATM network, which the specification describes as “an IP (Internet Protocol) network using an ATM (Asynchronous Transfer Mode), a connectionless IP packet needs to be transferred by a virtual connection ... as a connection-oriented technique which guarantees the quality.” (Col. 1, lines 28-33). A virtual connection (with endpoints defined by the AMInet routers 21 and 23, as disclosed in *Utsumi*), however, is inconsistent with a distributed network, allowing for the “broadcast” of a message, as defined by claim 1. For at least this additional reason, the application of *Utsumi* to claim 1 is misplaced and should be overturned.

As a separate and independent basis for the patentability of claim 1, the Office Action alleges that *Utsumi* teaches “generating a request for a component having at least one specified attribute (Col 2 lines 4-5).” (*Emphasis added*, Office Action, paragraph 4a). Applicant respectfully disagrees. This cited portion of *Utsumi* actually states: “input means for inputting a command based on an operation by a user.” In applying this teaching to the relevant element of claim 1, the Office Action apparently equates “a command” with the claimed “request.” Although the Office Action does not clearly apply these teachings, it is presumed that the disclosed “operation” is being applied to equate to either the claimed “component” or the claimed “attribute.” Either way, it is clear that a claimed feature is missing from the cited teaching of *Utsumi* (as the disclosed “operation” cannot be both a “component” and an “attribute”), and for at least this reason the rejection is misplaced and should be overturned.

Notwithstanding, the undersigned respectfully submits that the cited teachings of *Utsumi* are significantly different than the claimed features of the present invention, and that the rejection generally embodies a rationale that is fundamentally misplaced. In this regard, the present application specifically defines “components” to include “services, interfaces, resources, code segments, etc.” (page 1, lines 19-21). Likewise, “attributes” are used to specify a component. By way of illustration, one example presented in the present application was a “request” by a computer for a “component” (resource) of a network printer having an “attribute” of color printing. In that example, the color attribute was used to specify the printer component that was the subject of the generated request. Simply stated, the cited teaching of *Utsumi* (*i.e.*, “input means for inputting a command based on an operation by a user”) cannot be applied (even with the broadest possible application) to disclose or suggest

such a claimed feature. For at least this additional reason, the rejection is misplaced and should be overturned.

As yet another separate and independent basis for the patentability of claim 1, claim 1 recited "comparing at least one specified attribute of the received request with component attributes of the service provider." No such feature is taught, disclosed, or suggested in *Utsumi*. The Office Action alleged that this feature was disclosed at "col. 17 lines 26-28 and col. 2 lines 7-9). However, these locations of *Utsumi* actually disclose:

Next, a flexible set-up mechanism will be explained. In the ASP, resources can be reserved in various forms to use resources efficiently or to make resource reservation which matches with a request from an application....

.... control means for controlling the communication means so as to output an instruction signal, based on the command inputted through the input means.

As noted above, the system of *Utsumi* relates to resource allocation, in response to a user request for a resource. *Utsumi* does not disclose the request for a resource being specified by an attribute, and these above-disclosed portions of *Utsumi* certainly do not disclose this claimed feature. Instead, these portions of *Utsumi* disclose nothing more than the reservation of a resource in response to a user request. Claim 1, however, specifically claims the step of "comparing at least one specified attribute of the received request with the component attributes of the service provider." No such corresponding feature is disclosed or suggested in *Utsumi*. Therefore, for at least this additional reason, the rejection of claim 1 is misplaced and should be overturned.

For at least the foregoing reasons, the rejection of claim 1 should be overturned. For at least the same reasons the rejections of claims 2-11, which depend from claim 1, should be withdrawn as well.

Independent claim 20 encompasses certain similar features, and for purposes of this appeal, should be allowed for at least the same reasons advanced above in connection with claim 1.

Claims 12-19

The Office Action rejected independent claim 12 as allegedly obvious over the combination of *Utsumi* in view of *Gulati*. Claim 12 includes salient features of “means for generating a request ... for a component having at least one specified attribute”, “means for broadcasting the request across the network” and “means for comparing the at least one specified attribute of the received request with component attributes of the service provider.”

On a broadly-applied substantive basis, certain features of claim 12 loosely correspond to features discussed above in connection with claim 1. Therefore, the rejection of claim 12 should be overturned for many of the same reasons discussed above in distinguishing claim 1.

In addition, the FINAL Office Action improperly interpreted claim 12 to “encompass the same scope of the invention as that of the claims 1...” (FINAL Office Action, p. 5, lines 1-2). Applicant disagrees. Claim 1 is a method claim and claim 12 is an apparatus claim. Further, the elements of claim 12 are set forth in means-plus-function form, and as such require a differing interpretation. To date, however, the Examiner has failed to properly construe (and therefore apply) the elements of claim 12. For this reason alone, the Examiner’s rejection should be reversed as legally improper.

Pursuant to 35 U.S.C. § 112(6), a claim element recited in means-plus-function format “shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.” 35 U.S.C. § 112, ¶ 6. The Federal Circuit has clearly endorsed this statutory mandate by holding that claims interpreted under 35 U.S.C. § 112, paragraph 6, are limited to the corresponding structure disclosed in the specification and its equivalents. Kahn v. General Motors Corp. 135 F.3d 1472, 45 U.S.P.Q.2d 1608 (Fed. Cir. 1998).

There should be no question but that the elements recited in claim 12 are to be construed pursuant to 35 U.S.C. § 112, paragraph 6. In Greenberg v. Ethicon Endo-Surgical Inc., 91 F.3d 1580, 39 U.S.P.Q. 2d 1783 (Fed. Cir. 1996), the Federal Circuit stated that the use of “means for” language generally invokes 112(6). Indeed, only if means-plus-function claim elements recite sufficient structure to carry out the function are they taken out of the ambit of 35 U.S.C. § 112, paragraph 6. Cole v. Kimberly-Clark Corp., 102 F.3d 524, 41 U.S.P.Q.2d 1001 (Fed. Cir. 1996).

Indeed, the Federal Circuit reiterated in Sage Products, Inc. v. Devon Industries, Inc., 126 F.3d 1420, 44 U.S.P.Q.2d 1103 (Fed. Cir. 1998) that “the use of the word ‘means,’ which is part of the classic template for functional claim elements, gives rise to ‘a presumption that the inventor used the term advisedly to invoke the statutory mandates for means-plus-function clauses.” Ultimately, the Court in Sage construed the relevant claim elements under 35 U.S.C. § 112(6), because ‘means’ were recited, and the claim elements did not “explicitly recite[s] the structure, material, or acts needed to perform the [recited] functions. Sage at p. 1428. The Federal Circuit further acknowledged this presumption in Al-Site Corp. v. VSI International, Inc., 174 F.3d 1308, 50 U.S.P.Q.2d 1161 (Fed. Cir. 1999).

Thus, claim elements expressed in “means” plus function format are construed in accordance with 35 U.S.C. § 112, paragraph 6, as set forth above, and as further described in *In re Donaldson* 16 F.3d 1189, 29 U.S.P.Q.2d 1845 (Fed. Cir. 1994)(*en banc*). The following elements of claim 12, therefore, are to be construed in accordance with the structure disclosed in the specification: “means for generating a request ... for a component having at least one specified attribute”, “means for broadcasting the request across the network” and “means for comparing the at least one specified attribute of the received request with component attributes of the service provider.” Applicant notes that, in *In re Donaldson*, The Board of Patent Appeals and Interferences advanced the legal proposition that “limitations appearing in the specification are *not* to be read into the claims of an application.” *In re Donaldson* at 1848. This argument, however, was rejected by the Federal Circuit, which held, as a matter of law, that “one construing means-plus-function language in a claim must look to the specification and interpret that language in light of the corresponding structure ... described therein, and equivalents thereof. *In re Donaldson* at 1848. Furthermore, the holding in *In re Donaldson* does not conflict with the principle that claims are to be given their broadest reasonable interpretation during prosecution. *In re Donaldson* at 1850.

To date, however, the Examiner has failed to so construe these claim elements. Therefore, the rejection of claim 12 (being identical to the rejection of claim 1) is based on faulty and legally improper claim interpretation. For at least that reason, the rejection of claim 12 should be overturned.

With regard to dependent claims 13-19, the rejections to those claims should be overturned insofar as they depend from claim 12, and the rejection of claim 12 should be overturned.

Claim 21

Finally, the Office Action rejected independent claim 21 (paragraph 19) as allegedly obvious over the combination of *Utsumi* and *Gulati*. Claim 21 includes salient features of “generating a request for a component having at least one specified attribute”, “broadcasting the request across the network” and “comparing, at each of the plurality of service providers on the network, the at least one specified attribute of the received request with component attributes of the service provider.” These features were discussed in connection with the rejection of claim 1, and therefore the rejection of claim 21 should be overturned for at least the same reasons as claim 1.

In addition, claim 21 specifically provides that the “comparing” take place “at each of the plurality of service providers on the network,” and further defines the “communicating, from each of the plurality of service providers, a response to the requesting consumer.” These added features are not disclosed in *Utsumi*. In this regard, the requested resource (in the system of *Utsumi*) will be allocated by only one provider (not a plurality of providers). As such, *Utsumi* cannot be properly applied to claim 21, and the rejection of claim 21 should be overturned.

Errors in the Office Action

As a final matter, the undersigned notes that the Office Action was improperly accorded the status of FINAL. In this regard, the Office Action justified the status of FINAL by alleging that Applicant’s prior amendment necessitated the new grounds for rejection. In its filed response to the FINAL Office Action, Applicant traversed this rationale, noting that

the only substantive amendment made in response to the prior (non-Final) Office Action was the addition of the word “computer” in the preamble of the independent claims. This amendment should not have necessitated additional searching or new grounds of rejection. Indeed, Applicant made this amendment because it was clear from the first Office Action that the Examiner had completely misapplied wholly unrelated art to the claims of Applicant’s invention. In fact, as Applicant noted in its prior response, the amendment was made merely to confirm the only reasonable interpretation that could have been accorded to the claims in the first place and that no deviation in claim scope was intended by the amendment. The FINAL Office Action then applied new art (*Utsumi*), as the primary reference in rejecting the claims. To allege, as the FINAL Office Action does, that the mere addition of the word “computer” in the preamble so changed the claim scope and interpretation, is tantamount to an admission that the prior Office Action construed the claims without ANY reference or consideration of the fundamental teachings of the specification (ergo, the essence of the Applicant’s invention).

In this regard, the MPEP requires that the initial search be more thorough than apparently the one was in this application. For example, MPEP 704.01 requires that “[t]he invention should be thoroughly understood before a search is undertaken.” More significantly, MPEP 904.03 requires that:

...It is normally not enough that references be selected to meet only the terms of the claims alone ... but the search should ... also cover all subject matter which the examiner reasonably anticipates might be incorporated into applicant’s amendment....

In doing a complete search, the examiner should find and cite references that, while not needed for treating the claims, would be useful for forestalling the presentation of claims to other subject matter regarded by applicant as his or her invention...

In view of these, and other MPEP requirements, it is clear that that the '896 patent should have been cited in the previous Office Action. As the previous Office Action failed to cite this reference (which is now the primary reference of the present rejections), the FINAL status of the current office action was clearly premature and should have been withdrawn.

Notwithstanding the fact that Applicant pointed out this deficiency in responding to the FINAL Office Action, the Advisory Action maintained its position by citing that *Utsumi* failed to teach "broadcasting," and that Utsumi is only the primary reference of a 103 rejection and that "therefore the argument is not persuasive." (Advisory Action, continuation sheet) However, "broadcasting" was not added to the claims, so this comment of the Advisory Action makes no sense, and reflects an error on the part of the Examiner. Although the undersigned appreciates that the Board will not decide this issue (as the premature Finality of the rejection is an issue to be petitioned to the Commissioner and not appealed to the Board), the Board may consider the Examiner haste in rushing this case to FINAL as indicative of the lack of diligence that the Examiner has exercised in the examination of this application.

CONCLUSION

Based upon the foregoing discussion, Applicants respectfully requests that the Examiner's final rejection of claims 1-21 be overturned by the Board, and that the application be allowed to issue as a patent with all pending claims 1-21.

Application of Daniel Ford
Ser. No. 09/779,390

Please charge Hewlett-Packard Company's deposit account 08-2025 in the amount of \$500 for the filing of this Appeal Brief. No additional fees are believed to be due in connection with this Appeal Brief. If, however, any additional fees are deemed to be payable, you are hereby authorized to charge any such fees to deposit account No. 08-2025.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read 'Daniel R. McClure', written over a horizontal line.

Daniel R. McClure
Registration No. 38,962

(770) 933-9500

VIII. CLAIMS - APPENDIX

1. In a distributed computer networked system having at least one service consumer and at least one service provider, a method for accessing a remote software component by a service consumer comprising:

generating a request for a component having at least one specified attribute;

broadcasting the request across the network;

receiving the request at a service provider;

comparing at least one specified attribute of the received request with component attributes of the service provider; and

communicating a response to the requesting service consumer.

2. The method as defined in claim 1, wherein software component is selected from the group consisting of: a service, a resource, an interface, and a program segment.

3. The method as defined in claim 1, wherein the step of generating a request includes formulating a service descriptor, the service descriptor being an object that specifies the at least one specified attribute.

4. The method as defined in claim 1, wherein the step of broadcasting the request utilizes a multicast protocol for broadcasting the request across the network

5. The method as defined in claim 1, wherein the network is a local area network.

6. The method as defined in claim 1, wherein the network is a wide area network.
7. The method as defined in claim 1, wherein the step of communicating a response utilizes a unicast protocol.
8. The method as defined in claim 1, further including the step of formulating a response by the service provider, which response includes an identification of a network location of the service provider.
9. The method as defined in claim 8, further including the step of directly requesting the component from the service provider by the service consumer, in response to the response received by the service consumer.
10. The method as defined in claim 8, wherein the step of formulating a response further includes associating with the response code for interfacing with the requested component, without requiring a driver to be separately installed on the service consumer.
11. The method as defined in claim 10, wherein the code for interfacing with the requested code is Java code in the form of a stub object.
12. A distributed computer networked system for accessing a remote software component comprising:
 - at least one service consumer;

at least one service provider;

means for generating a request at a service consumer for a component having a least one specified attribute;

means for broadcasting the request across the network;

means for receiving the request at a service provider;

means for comparing the at least one specified attribute of the received request with component attributes of the service provider; and

means for communicating a response to the requesting service consumer.

13. The system as defined in claim 12, further including means for generating the response.

14. The system as defined in claim 13, wherein the means for generating the response is configured to include within the response a mechanism for identifying a network location for the component.

15. The system as defined in claim 13, wherein the means for generating the response is configured to include within the response a code segment that allows the service consumer that generated the request to interface with the component without having a separately installed driver on the service consumer.

16. The system as defined in claim 15, wherein the code segment includes Java code in the form of a stub object.

17. The system as defined in claim 13, wherein the means for broadcasting the request includes a multicast protocol.

18. The system as defined in claim 13, wherein the means for generating a request includes a service finder.

19. The system as defined in claim 13, further including means for consolidating responses and providing the consolidated responses to the service consumer

20. A distributed computer networked system for accessing a remote software component comprising:

- at least one service consumer;

- at least one service provider;

- a mechanism configured to generate a request at a service consumer for a component having a least one specified attribute;

- a mechanism configured to broadcast the request across the network;

- a mechanism configured to receive the request at a service provider;

- a mechanism configured to compare the at least one specified attribute of the received request with component attributes of the service provider; and

- a mechanism configured to communicate a response to the requesting service consumer.

21. In a distributed computer networked system having at least one service consumer and at least one service provider, a method for accessing remote software components by a service consumer comprising:

generating a request for a component having at least one specified attribute;

broadcasting the request across the network;

receiving the request at each of a plurality of service providers on the network;

comparing, at each of the plurality of service providers, the at least one specified attribute of the received request with component attributes of the service provider;
and

communicating, from each of the plurality of service providers, a response to the requesting service consumer.

IX. EVIDENCE - APPENDIX

None.

IX. RELATED PROCEEDINGS- APPENDIX

None.